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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,431	08/02/2000	Manuela Kunz	1222	3158
7590 05/12/2005				
Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743				
			EXAMINER EINSMANN, MARGARET V	
			ART UNIT 1751	PAPER NUMBER
DATE MAILED: 05/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/601,431

Applicant(s)

JAVET ET A L.

Examiner

Margaret Einsmann

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/17/03; 8/02/00.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Applicant's preliminary amendment has been entered. Pending claims 1-10 are being examined in this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Raue et al., US 4,542,224.

A composition for dyeing fibers, attained by mixing two components, wherein one component contains an enamine of formula or its physiologically tolerates salts as claimed and at least one carbonyl compound as claimed is disclosed in column 2 lines 31-55, wherein the enamine is compound (V) on lines 32-38 and/or compound (VI) on lines 42-48 and the carbonyl compound is formula VII on line 55. This disclosure anticipates claims 1 and 2. Example 3 in column 6 wherein 1,3,3-trimethyl-2-methylene-indoline is combined with 4-dimethylaminobenzaldehyde anticipates claims 1-4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moller, DE 197 17 222 A1 or DE 197 17 223 A1 or Moller, DE19717224 A1 or Moller , DE 197 17 280. According to the statement of relevancy presented by applicant with the IDS Of March 17, 2003, Moeller discloses compositions for dyeing keratin hair which comprise an aldehyde and/or ketone and additionally 1,2,3,3-tetramethyl-3H-indolium salts. The aldehyde or ketone is applicant's claimed carbonyl compound while 1,2,3,3-tetramethyl-3H-indolium salt is an enamine and is specifically claimed in applicant's claim 3. Since there is no example of using the indolium salt in a dyeing composition, the claims are not anticipated. It would have been obvious to the man having skill in the art at the time the invention was made that the indolium salt may be used in the disclosed compositions as they are listed in the patents as being equivalent for use in the compositions to dye hair. Accordingly one would expect acceptable dyeings when said compounds are included in the disclosed hair dyeing compositions. Regarding claim 5, it is within the skill of the artisan to determine amounts of each agent to use. Regarding claim 6, the claimed pH is such a broad range as to include all compositions which are acceptable for use on the scalp to avoid irritation.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no basis in claim 1 for "the ready-for-use dyeing agent" as claimed in claim 5 or for "one dyeing agent A" as recited in claim 7.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-10 of U.S. Patent No. 6,652,601 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both the patent and the instant application claim a dyeing composition comprising a carbonyl compound and a

compound which is an enamine a process temporarily dyeing with said compositions and then removing the dyeing with sulfite, and both also claim a multicompartment kit that is basically the same. The patent claims a specific enamine which is an indole or indolinium compound. This application claims the enamine broadly in the independent claim, and then in the list of enamine compounds specifically listed in claims 2 and 3 claims compounds which are position isomers of the indole specifically claimed in the patent. The claimed carbonyl compounds in each application are the same. See the claimed compounds in claim 3 of the patent and claim 4 of the instant application.


It would have been obvious to the man having skill in the art at the time the invention was made that the claims of this application would extend the life of the patent the claims of this application include the subject matter claimed in the patent since the indole/indolinium claimed in the patent is an enamine as claimed in the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-W and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/10/05


Margaret Einsmann
Primary Examiner
Art Unit 1751